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EXAMINER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KOJI TSUKIMORI and KEIJI HIRAI

Appeal 2009-015086
Application 10/799,617[1]
Technology Center 2100

Decided: May 18, 2010

Before JOSEPH L. DIXON, JAY P. LUCAS, and CAROLYN D. THOMAS, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeals from a final rejection of claims 9 to 36 under authority of 35 U.S.C. § 134(a). Claims 1 to 8 are cancelled. The Board of

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[1] Application filed March 15, 2004. Appellants claim the benefit under 35 U.S.C. § 119 of Japan application P2003-102165 filed April 4, 2003. The real party in interest is Sony Corporation of Tokyo, Japan.

Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b). Oral hearings were held on May 12, 2010.

We affirm the rejections.

Appellants' invention relates to an editing system in which frame synchronization (timing) signals are produced in a timing notice apparatus attached to a computer, rather than in the computer itself (Spec. 1, middle; Spec. 2, middle). In the words of Appellants:

> An editing system in which a personal computer is easily configured as an editing apparatus that performs editing processing in synchronization with predetermined timing. According to the invention, a personal computer 2 transmits an acquisition command C1 to a timing notice apparatus 4 over a USB cable 3, as a result, the personal computer 2 receives a timing notice signal S2 transmitted from the timing notice apparatus 4 under frame timing over the USE cable 3. Thus, it becomes possible to notify the personal computer 2 of the frame timing as reception timing of the timing notice signal S2 by connecting the timing notice apparatus 4 to the personal computer 2 over the USB cable 3 without the need of troublesome works such as installing a PC1 board in a main body of the personal computer 2, thereby realizing an editing system 1 in which the personal computer 2 is easily configured as an editing apparatus that performs editing processing in synchronization with predetermined timing.

(Abstract, Spec. 29).

Claim 9 is exemplary, and is reproduced below:

9. An editing system comprising:

a computer having a computer interface unit; said computer interface unit being adapted to transmit an acquisition command and to receive a timing notice signal; and

a timing notice apparatus having a controller and a timing generation unit, said controller being adapted to receive said acquisition command and to transmit said timing notice signal, said timing generation unit being adapted to extract frame synchronization information from a reference signal,

wherein said frame synchronization information extracted from said reference signal is said timing notice signal, and

wherein said timing notice apparatus transmits said timing notice signal upon receipt of said acquisition command, said timing notice signal being transmitted according to a predetermined timing of image data

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Iizuka	US 5,680,596	Oct. 21, 1997

Applicant's Admitted Prior Art ("AAPA")

REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 9 to 36 stand rejected under 35 U.S.C. § 103(a) for being obvious over AAPA in view of Iizuka.

Appellants contend that the references Iizuka and the admitted prior art do not render the claimed subject matter unpatentable, as the references do no teach claimed limitations. The Examiner contends that each of the claims is properly rejected.

We will review the rejections in the order argued. The claims are grouped together, as per Appellants' Briefs. We have only considered those arguments that Appellants actually raised in the Briefs. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37 (c)(1)(vii).

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue specifically turns on whether Iizuka teaches frame synchronization information extracted from a reference signal, as claimed.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented an editing system based on a personal computer in which frame synchronization information for the image data being edited is calculated based on a reference signal (Spec. 1, middle). The invention is based on a hardware platform of said computer connected to a timing notice apparatus by a USB cable (Spec. 2, middle). An acquisition command to the apparatus starts the generation of the timing

notice signal that is then sent to the computer that sent the acquisition command (Spec. 3, top; Fig. 2).

2. The Iizuka reference teaches a system for generating and tuning timing signals for the transfer of image data from a computer to a device, such as a printer (Col. 1, ll. 13 to 18). To tune the timing of control signals, to allow for the length of a USB or other cable, various communications go back and forth between the computer and the printer (Col. 6, ll. 4 to 37). In the tuning mode, a tuning data request command is transmitted from the computer to the printer (*id.*). In response, tuning data produced by a state transition time measuring circuit is sent back to the computer (*id.*). A tuning sequencer 41 in the time measuring circuit calculates the tuning data from reference signals (Col. 4, ll. 50 to 60).

PRINCIPLES OF LAW

BURDEN AND REVIEW STANDARDS

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

"It is common sense that familiar items may have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 402 (2007).

"A court must ask whether the improvement is more than the predictable use of prior-art elements according to their established functions." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 401 (2007).

All of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art. The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain. *In re Lemelson*, 397 F.2d 1006, 1009 (CCPA 1968).) (citing *In re Boe*, 355 F.2d 961, 965 (CCPA 1966)

In sustaining a multiple reference rejection under 35 U.S.C. § 103(a), the Board may rely on one reference alone without designating it as a new ground of rejection. *In re Bush*, 296 F.2d 491, 496 (CCPA 1961); *In re Boyer*, 363 F.2d 455, 458 n.2 (CCPA 1966).

ANALYSIS

From our review of the administrative record, we find that the Examiner presents conclusions of unpatentability on pages 3 to 7 of the Examiner's Answer. In opposition, Appellants present a number of

arguments. The arguments are applicable to all claims, so the rejection of all claims will be considered together.

Arguments with respect to the rejection of claims 9 to 36 under 35 U.S.C. § 103(a)

The Examiner has rejected the noted claims for being obvious over the Appellants' admitted prior art, mainly the second paragraph of the Description of Related Art (Spec. 1, middle) and the patent reference Iizuka. The Examiner has summarized his reasoning in the Answer (Ans. 7, bottom).

Appellants argue that the Examiner admits the AAPA fails to teach a controller adapted to receive the acquisition command and to transmit the timing notice signal; and to teach an editing system, wherein the timing notice signal is frame synchronization information, is extracted from a reference signal (App. Br. 12, middle). Appellants then contend that the Examiner fails to show where Iizuka teaches a reference signal and the timing notice signal (App. Br. 13, middle). Thus, contend the Appellants, neither reference teaches the claimed invention.

We do not find the Appellants' arguments convincing. With regard to the AAPA, we agree with the Examiner's analysis which finds that the Appellants have "essentially [taken] a computer component (ie, the claimed 'timing notice apparatus') that has previously been placed inside of a computer (e.g., using a PCI board), and provided it as an external device." (Ans. 7, bottom). The claimed interface unit would be an obvious addition to allow the (now) two halves of the once single machine to communicate,

and we find such is taught by Iizuka's input/output units 18 and 28. (*See* Iizuka, Fig. 2.)

In addition, we find Iizuka alone teaches the computer with the interface unit (Fig. 2, #1), the equivalent of the timing notice apparatus (Fig. 2, #2) with a controller (CPU 21) and a timing generation unit (#29 and associated circuitry), which receives an acquisition command (equivalent to the tuning request command, Col. 6, l. 30) and in response transmits a timing notice signal (tuning data, Col. 6, l. 31). The timing notice signal (tuning data) is extracted from reference signals REF supplied to the time measuring circuits 29 of the timing generation unit 2 (Col. 4, l. 58; col. 5, l. 15). We find it would be obvious to use the Iizuka device as the editing system disclosed in the AAPA.

We find the analysis above to answer the challenges of Appellants against the references (App. Br. 14).

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CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 9 to 36.

DECISION

We affirm the Examiner's rejection of claims 9 to 36.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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